REMARKS

This is a full and timely response to the non-final Official Action mailed May 19, 2004 (Paper No. 7). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the present amendment, claims 32-41 are cancelled. Various other claims are amended. No claims are added. Thus, claims 1-31 and 42-51 are currently pending for further action.

The final Office Action indicates the presence of allowable subject matter in claims 42 and 43. Applicant wishes to thank the Examiner for this indication of allowable subject matter.

Accordingly, claims 42 and 43 have each been amended herein and rewritten as an independent claim, containing all the recitations of their former respective base and intervening claims. Consequently, following entry of this amendment, claims 42 and 43 should be in condition for immediate allowance and notice to that effect is respectfully requested.

With regard to the prior art, claims 1, 4-8, 10-12, 14-18, 20-22, 26-29, 31-33, 36-40, 44, 45 and 49-51 were rejected as being anticipated under 35 U.S.C. § 102(a) by U.S. Patent No. 5,003,591 to Kauffman et al. ("Kauffman"). Claims 3, 9, 13, 19, 24, 30, 35, 41 and 46-48 were rejected as unpatentable under 35 U.S.C. § 103(a) over Kauffman, taken alone. Claims 2, 12, 23 and 34 were rejected under § 103(a) over Kauffman in view of prior art allegedly admitted by Applicant. For at least the following reasons, these rejections are respectfully traversed.

Claim 1 recites:

> A method of controlling the downloading of code and data objects by a set-top terminal in a cable television system, the method comprising transmitting a download control message to said set-top terminal, wherein said download control message specifies an object to be downloaded, a ROMable size of said object and a location of said object such that said set-top terminal is enabled to commence downloading said object upon receipt of said download control message.

(emphasis added)

In contrast, Kauffman does not teach or suggest a method including a download control message that specifies the ROMable size of an object to be downloaded. In this regard, the Office Action cited Kauffman at col. 3, line 39 to col. 4, line 2 and col. 7, lines 29-38. In pertinent part, these sections of Kauffman teach that

> When billing system 22 assigns a new firmware package to a particular converter 40, addressable controller 14 is commanded to transmit instructions to the converter. The instructions are received by microprocessor 50, and include an identifier specifying which firmware package to receive, where to find the firmware package (i.e., on the primary or a specified secondary channel), a predetermined time limit defining how long the converter should attempt to receive the firmware before aborting, a key to use in decrypting the data in the event it is encrypted, and the maximum segment number to be loaded (indicating how many segments are included in the firmware package to be received).

Col. 7, lines 29-38.

Thus, Kauffman merely teaches specifying a number of packets (i.e., the maximum segment number) into which the firmware is divided for transmission. Kauffman does not teach or suggest the claimed download control message that specifies the ROMable size of an object to be downloaded. Moreover, the Office Action does to specifically address how or where Kauffman contains such a teaching.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed.

Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, for at least this reason, the rejection of claims 1-10, 44 and 48 should be reconsidered and withdrawn.

Similar to claim 1, claim 11 recites:

> A system for controlling the downloading of code and data objects by a set-top terminal in a cable television system, the system comprising:
> a set-top terminal connected to a cable television system; and
> means for transmitting a download control message to said set-top terminal;
> wherein said download control message specifies an object to be downloaded, a size of said object and a location of said object such that said set-top terminal is enabled to commence downloading said object upon receipt of said download control message; and
> wherein said code or data object is added to firmware of said set-top terminal.

(emphasis added).

Similarly, claim 21 recites:

> A method of controlling the downloading of code and data objects by a set-top terminal in a cable television system, wherein said set-top terminal executes firmware, the method comprising:
> transmitting a download control message to said set-top terminal, wherein said download control message specifies an object to be downloaded, a size of said object and a location of said object such that said set-top terminal is enabled to commence downloading said object upon receipt of said download control message; an d
> adding said code or data object to the firmware of said set-top terminal.

(emphasis added).

As demonstrated above, Kauffman fails to teach or suggest a download control message that specifies the size of an object to be downloaded, as opposed to a number of packets or segments being transmitted. Again, "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, for at least this reason, the rejection of claims 11-31 45-47, 49 and 51 should be reconsidered and withdrawn.

Claim 13 recites that "said location of said object specified by said download control message includes a URL at which said object is stored." In rejecting this claim, the final Office Action "takes OFFICIAL NOTICE that it is notoriously well known in the art to utilize a 'URL' as a means for locating a software object." (Paper No. 7, p. 8). This is insufficient.

Applicant's invention is not implemented on the Internet where, as the final Action notes, URLs are well known. Applicant invention is, instead, a method used within "a cable television system." It was not notoriously well known to use URL's in a cable television system at the time of Applicant's invention. More importantly, it is not obvious based on the prior art of record to include a URL in a download control message.

For at least these reasons, the rejection of claim 13 should be reconsidered and withdrawn.

Claim 17 recites:

> A system for controlling the downloading of code and data objects by a set-top terminal in a cable television system, the system comprising:
> a set-top terminal connected to a cable television system; and
> means for transmitting a download control message to said set-top terminal;
> wherein said download control message specifies an object to be downloaded, a size of said object and a location of said object such that said set-top terminal is enabled to commence downloading said object upon receipt of said download control message;
> wherein said code or data object is added to firmware of said set-top terminal; and
> wherein said set-top terminal further comprises:
> means for downloading said object in accordance with said download control message; and
> <u>means for terminating said downloading if a timer exceeds a set limit prior to receipt of a next successive data packet of said object</u>.

(emphasis added).

Similarly, claim 28 recites:

> A method of controlling the downloading of code and data objects by a set-top terminal in a cable television system, wherein said set-top terminal executes firmware, the method comprising:
>
> transmitting a download control message to said set-top terminal, wherein said download control message specifies an object to be downloaded, a size of said object and a location of said object such that said set-top terminal is enabled to commence downloading said object upon receipt of said download control message;
>
> adding said code or data object to the firmware of said set-top terminal;
>
> downloading said object in accordance with said download control message; and
>
> terminating said downloading if a timer exceeds a set limit prior to receipt of a next successive data packet of said object.

(emphasis added).

In contrast, Kauffman only teaches a timer that times the total amount of time required to download an object, not the time between receipt of successive data packets as claimed. Kauffman teaches: "While the firmware is being received, timer 64 counts down the time-out period specified in the download command. If the timer expires, microprocessor 50 aborts the download, and returns to the original data channel. The time-out period specified in the download command can be varied depending on the amount of firmware to be downloaded." (Col. 7, lines 41-48).

Nowhere does Kauffman teach or suggest timing the interval between receipt of successive data packets to monitor the downloading of a data object as claimed. Thus, Kauffman fails to teach or suggest all the features of claims 17 and 28. Consequently, the rejection of claims 17 and 28 should be reconsidered and withdrawn.

Claim 19 recites:

> A system for controlling the downloading of code and data objects by a set-top terminal in a cable television system, the system comprising:
>
> a set-top terminal connected to a cable television system; and
>
> means for transmitting a download control message to said set-top terminal;

wherein said download control message specifies an object to be downloaded, a size of said object and a location of said object such that said set-top terminal is enabled to commence downloading said object upon receipt of said download control message;

wherein said code or data object is added to firmware of said set-top terminal; and

wherein said download control message is embedded in an entitlement management message that is transmitted from a headend facility to said set-top terminal.

(emphasis added).

Similarly, claim 30 recites:

A method of controlling the downloading of code and data objects by a set-top terminal in a cable television system, wherein said set-top terminal executes firmware, the method comprising:

transmitting a download control message to said set-top terminal, wherein said download control message specifies an object to be downloaded, a size of said object and a location of said object such that said set-top terminal is enabled to commence downloading said object upon receipt of said download control message;

adding said code or data object to the firmware of said set-top terminal; and

embedding said download control message in an entitlement management message that is transmitted from a headend facility to said set-top terminal.

(emphasis added).

In contrast, Kauffman does not teach or suggest the inclusion of a download control message in an entitlement management message. In this regard, the final Office Action "takes OFFICIAL NOTICE that the particular usage of 'entitlement management messages' in conjunction with cable systems." (Paper No. 7, p. 8). The Action goes on, without further support, to allege that the subject matter of claims 19 and 30 would have been obvious. This is clearly incorrect and insufficient to support a rejection of these claims.

"The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. In re Ahlert, 424 F. 2d 1088, 165 USPQ 418, 420 (CCPA 1970). . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." M.P.E.P § 2144.03.

Applicant strongly disagrees that the use of an entitlement management message to carry a download control message is known in the art. Accordingly, Applicant respectfully traverses the Official Notice taken in this instance and requests that a reference be cited supporting a rejection of claims 19 and 30. Until such a reference has been made of record, no *prima facie* case of unpatentability has been made, and the rejection of claims 19 and 30 should be reconsidered and withdrawn.

Claim 44 recites "storing said object upon download in volatile memory or non-volatile memory in accordance with data in said download control message." In reading this claim, reference should be had to Applicant's specification at, for example, page 12, lines 11-14. This portion of Applicant's specification states that "the Download Control Message of the present invention may provide an instruction as to how the object being acquired is to be stored in memory (112), for example, volatile memory, non-volatile memory or 'any.'"

Thus, when read according to basic English construction, and particularly in light of the specification, it is perfectly clear that claim 44 recites that whether a downloaded object is stored in volatile or non-volatile memory is determined by or "in accordance with" data in the download control message.

According to the final Office Action, claim 44 "does not particularly require that the 'data in said download control message' particularly identifies the type of memory to utilize in storage." (Paper No. 7, p. 6). Applicant disagrees.

As demonstrated above, claim 44 does state that data in the download control message determines in what type of memory downloaded data is stored. It would be a clear misreading of claim 44 to hold otherwise.

With this clarification, it becomes clear that the prior art of record fails to teach or suggest the subject matter of claim 44. Therefore, the rejection of claim 44 should be reconsidered and withdrawn.

Claim 45 recites similar subject matter to claim 44, but is even more emphatic. Claim 45 recites:

> A system for controlling the downloading of code and data objects by a set-top terminal in a cable television system, the system comprising:
> a set-top terminal connected to a cable television system; and
> means for transmitting a download control message to said set-top terminal;
> wherein said download control message specifies an object to be downloaded, a size of said object and a location of said object such that said set-top terminal is enabled to commence downloading said object upon receipt of said download control message; and
> wherein said code or data object is added to firmware of said set-top terminal;
> wherein said download control message specifies whether a downloaded object should be stored in volatile or non-volatile memory.

(emphasis added).

Thus, claim 45 unequivocally states that the download control message specifies where a downloaded object is to be stored, in volatile or non-volatile memory.

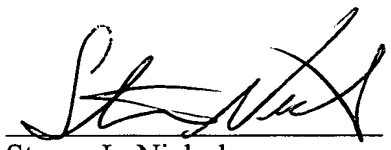
The prior art of record fails to teach or suggest the subject matter of claim 45, and the final Action has not indicated how or where such subject matter is taught by the prior art. Therefore, the rejection of claim 45 should be reconsidered and withdrawn.

Entry and consideration of this amendment are proper under 37 C.F.R. § 1.116 for at least the following reasons. The present amendment merely amends formerly dependent claims to present those claims in independent form. The amendment does not raise new issues requiring further search or consideration. In the case of claims 42 and 43, the amendment makes only those changes necessary to place the claims in condition for

allowance as indicated by the Examiner. Therefore, entry of the present amendment is proper under 37 C.F.R. § 116 and is hereby requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



DATE: 28 July 2004

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